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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re EIS International, Inc.¹

Serial No. 75/510,510

James C. Wray, Esq. for EIS International, Inc.

Lisa W. Rosaya, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Hohein, Chapman, and Rogers, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On June 29, 1998, EIS International, Inc.'s
predecessor-in-interest filed an application to register
the mark VIRTUAL CENTER FORECASTER on the Principal
Register for "computer software, namely software for
combining call information from multiple remote sites and
call centers in one central site, and database for running
global forecasts by using central to remote site queue
cross in the field of scheduling, and related documentation

¹ The application was filed by Cybernetics Systems International Corp. The records of the Assignment Branch of this Office indicate that the application has been assigned to EIS International, Inc. (Reel 2012, Frame 0975). Accordingly, applicant is now referenced as EIS International, Inc.

and manuals sold as a unit therewith" in International Class 9. The application was filed on June 29, 1998, based on applicant's claimed date of first use and first use in commerce of April 1998.

The Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the mark VIRTUAL CENTER FORECASTER, when used on or in connection with the identified goods of applicant, is merely descriptive of them.²

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. Applicant requested an oral hearing, but subsequently withdrew its request.

The Examining Attorney contends that "as a combination of two merely descriptive components - 'virtual center' and 'forecaster' - the applicant's proposed mark merely describes a feature, function, use or purpose of applicant's goods, namely, the software is used to create a virtual center which forecasts future call volume and staffing and management requirements." (Brief, pp. 3-4).

² The final refusal to register also included a requirement to further amend the identification of goods. However, in her brief, the Examining Attorney withdrew that requirement. Thus, we consider the amended identification of goods, filed March 25, 1999, to be accepted and the issue on appeal is limited to the refusal to register under Section 2(e)(1).

Specifically, the Examining Attorney argues that "virtual center" is a term of art in the telemarketing and customer service businesses which refers to a networking of multiple call centers and customer information databases into one "virtual center" to globally manage various types of data; that "forecaster" (as a variation of the word "forecast") is defined as a person or thing that predicts coming events or conditions; and that the combination of these two descriptive components does not create a different commercial impression, resulting in a non-descriptive mark.

The record relied on by the Examining Attorney includes applicant's specimens of record; dictionary definitions of the word "virtual,"³ "center" and "forecast"; and approximately fifteen excerpted stories reprinted from the Nexis database showing use of the words "virtual center(s)" or "virtual centre(s)."

Applicant contends that the Examining Attorney has dissected the mark, without considering the mark as a whole; that the commercial impression of a composite mark may be arbitrary or suggestive even if the separate

³ The Examining Attorney's request in footnote 3 of her brief that the Board take judicial notice of a dictionary definition of "virtual" is granted. See TBMP §712.

component parts are descriptive; and that applicant's mark is only suggestive of its goods.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A mark is merely descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also, *In re Abcor Development Corporation*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." See *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Entenmanns Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd*, *unpub'd*, Fed. Cir. February 13, 1991.

Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in

which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services.

See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995).

Applicant's goods appear to be highly technical computer software. The specimens of record include the following statement:

Virtual Center Forecaster™ allows you to combine call information from multiple call centers (referred to as remote sites) into one central database (referred to as the central site) for the purpose of running a global forecast by using a central to remote site queue cross reference. ... Once a global forecast has been created using the WorkForce Manager™, the Virtual Center Forecaster™ enables you to distribute the call forecast and requirements back out amongst the remote site call centers.

The evidence of record (applicant's specimens, dictionary definitions and Nexis stories) simply does not establish that the mark, VIRTUAL CENTER FORECASTER, when considered in its entirety, is merely descriptive. That is, applicant's mark, as used on its computer software, does not convey an immediate idea about the goods with any degree of particularity. The combination of these three words is capable of different meanings, and it is not clear whether the purchasing public would regard the words

comprising the mark as signifying the combination of the terms "virtual center" and "forecaster" or, instead, "virtual" and "center forecaster." The significance of the mark as a whole, when applied to the goods, is ambiguous and unclear, and we find the mark is therefore suggestive of the goods.

The Examining Attorney submitted no Nexis evidence showing any uses of the three-word combination involved here. And the Nexis excerpted stories submitted by the Examining Attorney show that there are various uses and meanings of the two-word combination "virtual center," as exemplified by the examples set forth below (underlining added):

- (1) ... industry," Armentrout says.
"Part of the application of that technology can be through virtual teams." ARCO has set up what might be described as virtual centers of excellence: pools of experts in areas such as seismic technologies, reservoir management and drilling, "Computerworld," April 28, 1997;
- (2) In fact, over the past three years, the multilevel site has developed into a "Virtual Center" - the so-called "Diesel Planet." Spread over hundreds of Web pages, the site offers visitors clothing-collection information, ..., "The Seybold Report on Internet Publishing," February 1, 1999; and

- (3) Intermedia Communications said it plans to link multiple call centers into [a] single "virtual" center, using Genesys Telecom Labs computer-telephony [sic] integration equipment. Intermedia also selected Edify's software to provide interactive voice..., "Communications Daily," June 17, 1998.

The prohibition against registration of merely descriptive designations is intended to prevent one party from precluding all others from fair use of descriptive terminology in connection with goods (or services) which are described thereby. Nothing in the record suggests that others in the relevant field have used or would need to use the three-word combination VIRTUAL CENTER FORECASTER to describe their goods.

The Board has noted many times that there is a thin line of demarcation between a suggestive and a descriptive mark, and further that if there is doubt about the "merely descriptive" character of a mark, that doubt is resolved in applicant's favor, allowing publication of the mark so that any third-party may file an opposition to develop a more comprehensive record. See *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992).

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Decision: The refusal under Section 2(e)(1) of the
Trademark Act is reversed.

G. D. Hohein

B. A. Chapman

G. F. Rogers
Administrative Trademark Judges,
Trademark Trial and Appeal Board